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09/368,505	08/05/1999	GERD BRANDHORST	1860/48111RE	5618

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Washington,, DC 20044-4300

EXAMINER
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DERAKSHANI, PHILIPPE

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 38

Application Number: 09/368,505  
Filing Date: August 05, 1999  
Appellant(s): BRANDHORST ET AL.

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Herbert I. Cantor  
For Appellant

EXAMINER'S ANSWER

**MAILED**  
**DEC 28 2005**  
**Group 3700**

This is in response to the appeal brief filed 4/10/02.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-20 and 23-25 are allowed.

This appeal involves claims 21-22 and 26-38.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Issue A is no longer an issue.

**(7) *Grouping of Claims***

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Issue A, claims 6-10, 14-16, 18, 20, 22, 25, 28 and 34-38 are longer an issue.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-22 and 26-38 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the

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present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The supporting surface is part of the structure used to define the “gap” or “play” and it is this limitation that cannot be removed from the claims. The new claims submitted in the reissue do not define the “gap” or “play” in this manner. The definition of the gap cannot be broadened since it is the portion of the claim that was put in the independent claims to make them allowable. In US 09/371,219 original claim 3 was allowed for the gap/play limitation. Applicant amended said parents by including the limitation of said claim into the independent claim.

**(11) Response to Argument**

Appellant contends (page 11 of brief on appeal) that the limitation 1 in the originally filed claim 3 for 08/371,219 or 5,501,368 “said housing has a ring supporting surface” was not relied upon for patentability. Limitation 2 states “mutually facing surfaces”. There are two supporting surfaces, one for the cap (2) and one for the ring (17). Original claim 3 in 5,501,368 was allowed because of the “gap” or “play” between both supporting surfaces. Thus the limitation for both supporting surfaces was relied upon patentability.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

PHILIPPE S DERAKSHANI

Primary Examiner

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 9/19/05

PD

September 19, 2005

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